

### **REMARKS**

The issues outstanding in the Office Action of August 27, 2009, are the rejections under 35 U.S.C. 112, 102 and 103. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

#### **Rejection Under 35 U.S.C. 112**

Claims 1-6, 8-26, 28-31 and 36-44 have been rejected under 35 U.S.C. 112, second paragraph. Reconsideration of this rejection is respectfully requested. The Examiner is thanked for pointing out various inconsistencies in language. The claims have been edited to make changes of a grammatical and typographical nature. It is submitted that the claims accordingly fully satisfy the requirements of the statute, and that the clarifying amendments have not changed the scope of the claims either literally, or for purposes of the doctrine of equivalents. It is moreover noted that brand names have been deleted from claim 24. Accordingly, withdrawal of the rejection is respectfully requested.

#### **Rejection Under 35 U.S.C. 103**

Claims 1-6, 8-26, 28-31 and 36-44 have been rejected under 35 U.S.C. 103 over Wurm '024 taken with Barker '026 or '935. Reconsideration of this rejection is respectfully requested.

Wurm discloses a process for the production of  $\text{LiFePO}_4$ , involving dissolving precursor ions, producing a precipitate thereof, decomposing the precipitate at temperatures up to 500°C, annealing the decomposed product at less than 800°C, and obtaining the product. See paragraphs 9-13. However, this published application does not disclose the use of hydrothermal conditions to produce the product (as admitted at page 2 of the Office Action) and also does not disclose dispersing or milling the precursor mixture or suspension until the D90 value of the particles of the precipitate are less than 50 microns. While the Office Action argues that the precursor suspension in Wurm would be dispersed "to no less extent than when the precursor suspension recited in Applicant's claims" there is no support given for this presumptive conclusion. Indeed, there is no basis for this assumption, inasmuch as Wurm does not disclose the size of the product

subsequent to the decomposing step, at best disclosing that materials with a size of less than one micron are produced subsequent to annealing. See paragraph 20. Instead, the present invention is based on the discovery that the use of the dispersing/milling step to produce a D90 less than 50 microns, coupled with hydrothermal treatment, results in a material which produces not only small particle size but also a small particle size distribution.

The two Barker disclosures, disclosing methods for forming transition metal phosphates and indicating that hydrothermal treatments are useful in the production of various organic materials, do not remedy the deficiency of the primary reference. The Applicants in either Barker application do not teach that the coupling of hydrothermal treatment along with dispersion or milling can result in such a material having a particle size *and* distribution which are both small. As a result, it is submitted that one of ordinary skill in the art viewing these references would not be motivated to use both hydrothermal treatment coupled with dispersion or milling, inasmuch as the present advantageous small particle size and small particle distribution is not taught by the references. Withdrawal of the references under 35 U.S.C. 103 is accordingly respectfully requested.

Claims 41-44 have been rejected under 35 U.S.C. 102(e) or in the alternative 103 over Wurm and the two Barker disclosures, as discussed above. Reconsideration of this rejection is also respectfully requested.

It is argued, at page 3 of the Office Action, that there is no showing on record that the material produced in claims 41-44 would “necessarily” be different from that of Wurm and Barker, apparently in combination. However, this is not submitted to be the correct legal test. In order for there to be an inherent anticipation, the courts have held that the material must “necessarily and inevitably” be produced by the process claimed. In order for a reference which neither expressly describes or teaches the subject matter alleged to anticipate, the reference must provide enough information to permit an inference that the subject matter is inherent. See, for example, *Ex parte Garvin*, 62 USPQ 2d 1680 (BPAI 2001). Relying upon a theory of inherency, the PTO must provide a basis in fact and/or technical reasoning to reasonably support the determination that an allegedly inherent characteristic is necessarily present from the teachings of the prior art. See *Ex parte Levy*, 17 USPQ 2d, 1461 (BPAI 1990). Moreover, inherency must be a necessary

result, and not merely a possible result. See *In re Oelrich*, 666 F2d. 578, 212 USPQ 323 (CCPA 1971). It is submitted that the necessary proofs have not been offered in the Office Action. Accordingly, withdrawal of this rejection is also respectfully requested.

In conclusion, it is submitted that the claims are in condition for allowance, and withdrawal of all rejections and passage to issue is respectfully requested. However, if the Examiner has any questions or comments, he is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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